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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,634	11/09/2001	Marc Alizon	3495.0104-03	5658

22852 7590 05/13/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

PARKIN, JEFFREY S

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,634

Applicant(s)

ALIZON ET AL.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-29 is/are pending in the application.
4a) Of the above claim(s) 16-21 and 26-29 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 22-25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Serial No.: 09/986,634
Applicants: Alizon, M., et al.

Docket No.: 3495.0104-03
Filing Date: 11/09/01

Response to Amendment

Status of the Claims

Acknowledgement is hereby made of receipt and entry of the communication filed 03 February, 2004. Claims 16-21 and 26-29 stand withdrawn from further consideration by the examiner, pursuant to 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. Claims 22-25 are currently under examination.

35 U.S.C. § 112, Second Paragraph

The previous rejection of claims 22-25 under 35 U.S.C. § 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is hereby withdrawn in response to applicants' amendment.

35 U.S.C. § 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-25 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *In re Rasmussen*, 650 F.2d 1212, 211 U.S.P.Q. 323 (C.C.P.A. 1981). *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976).

To satisfy the written description requirement, a patent

specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Vas-Cath, Inc., v. Mahurkar*, 935 F.2d at 1563, 19 U.S.P.Q.2d at 1116. As previously set forth, the issue raised in this application is whether the original application provides adequate support for the broadly claimed genus of polypeptides, and fragments thereof, encoded by a series of cDNA fragments from the viral clone having the C.N.C.M. accession no. I-627 (pROD 4.7). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997). The claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequence described only by functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the biomolecule of interest. *In re Bell*, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993). *In re Deuel*, 51 F.3d 1552, 34 U.S.P.Q.2d 1210 (Fed. Cir. 1995). A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 U.S.P.Q.2d 1895, 1905 (Fed. Cir. 1995). The court noted in this decision that a "laundry list" disclosure of every

possible moiety does not constitute a written description of every species in a genus because it would not reasonably lead those skilled in the art to any particular species.

An applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. For some biomolecules, examples of identifying characteristics include a nucleotide or amino acid sequence, chemical structure, binding affinity, binding specificity, and molecular weight. The written description requirement may be satisfied through disclosure of function and minimal structure when there is a well-established correlation between structure and function. Without such a correlation, the capability to recognize or understand the structure from the mere recitation of function and minimal structure is highly unlikely. In the latter case, disclosure of function alone is little more than a wish for possession; it does not satisfy the written description requirement. *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 U.S.P.Q.2d 1398, 1404, 1406 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998). *In re Wilder*, 736 F.2d 1516, 1521, 222 U.S.P.Q. 369, 372-3 (Fed. Cir. 1984). Factors to be considered in determining whether there is sufficient evidence of possession include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a

known or disclosed correlation between structure and function, and the method of making the claimed invention.

The deposited nucleic acid bearing the accession no. I-627 (pROD 4.7) is a full-length viral genomic clone of HIV-2_{ROD} that was obtained from a circular DNA form. A restriction map or the nucleotide sequence of this 9.5 kb clone was not provided. Attendant open reading frames and their amino acid sequences were not set forth. Thus, the coding potential of the pROD 4.7 insert remains to be elucidated. It is quite feasible, considering the quasispecies nature of HIV-1 and -2, that said sequence is defective in one or more locations and replication-impaired. The disclosure describes the preliminary cloning and characterization of a novel HIV-2 retrovirus. A small number of clones were generated and preliminary restriction maps and sequence data was obtained. No such data was provided for I-627. There is a single example in the disclosure providing a generic discussion of how to prepare DNA probes for use in diagnostic kits. However, the disclosure clearly fails to identify a single HIV-2 protein, or fragment thereof, and suitable pROD 4.7 nucleic acid fragments that are capable of encoding said proteins. Accordingly, the skilled artisan would reasonably conclude that applicants were not in possession of the claimed invention at the time of filing. Clearly this is an attempt by applicants to obtain subject matter to which they are not entitled.

Applicants traverse and submit that an adequate written description is provided in the specification. Particular reference was made to restriction maps and various cDNA clones that were utilized to prepare a full-length genomic clone. Hybridization reactions were also referenced in support of the claimed invention. These arguments and references fail to address the deficiencies noted above. None of the passages relied upon disclose the preparation of HIV-2_{ROD} polypeptide fragments from the deposited

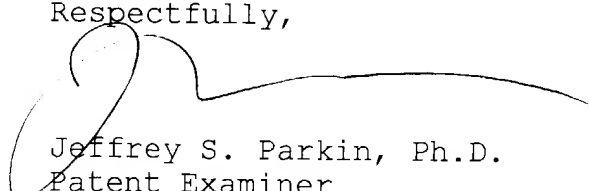
genome. The disclosure details the preliminary characterization of a novel HIV-2. However, at the time of filing the disclosure failed to provide any details concerning the molecular characteristics of the virus. The complete nucleotide sequence and coding potential of the ROD virus were not provided. The examples relied upon by applicants fail to disclose the preparation of polypeptides, or fragments thereof, from the deposited nucleic acid. Accordingly, the skilled artisan would reasonably conclude that applicants were not in possession of the claimed invention at the time of filing.

Correspondence

Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 9:30 AM to 7:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisors, Laurie Scheiner or James Housel, can be reached at (571) 272-0910 or (571) 272-0902, respectively. Direct general inquiries to the Technology Center 1600 receptionist at (571) 272-1600.

Formal communications may be submitted through the official facsimile number which is (703) 872-9306. Hand-carried formal communications should be directed toward the customer window located in Crystal Plaza Two, 2011 South Clark Place, Arlington, VA. Applicants are directed toward the O.G. Notice for further guidance. 1280 O.G. 681. Informal communications may be submitted to the Examiner's RightFAX account at (571) 273-0908.

Respectfully,



Jeffrey S. Parkin, Ph.D.
Patent Examiner
Art Unit 1648

10 May, 2004